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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,941	03/31/2000	Hans-Detlef Luginsland	PM 258030/99003250	9776

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Pillsbury Winthrop LLP  
1600 Tysons Boulevard  
McLean, VA 22102

EXAMINER

LEE, RIP A

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 11/04/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/538,941

Agent(s)

LUGINSLAND, HANS-DETLEF

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action follows a response filed on August 9, 2002. Claims 1, 5-10, 12, and 13 were amended to correct matters of form, and new claims 15-20 were added.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-8 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,159,009 to Wolff *et al.* for the same reasons set forth in paragraph 10 of the previous office action (Paper No. 7).

5. Claims 9-14 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff *et al.* in view of U.S. Patent No. 6,008,295 to Takeichi *et al.* for the same reasons set forth in paragraph 13 of the previous office action.

### *Response to Arguments*

6. The Applicants traverse the rejection of claims 1-8 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,159,009 to Wolff *et al.* The Applicant's arguments have been considered fully, but they are not persuasive.

The Applicants claim that the general formula in the prior art do not literally describe organosilanes of the present invention. Furthermore, it is submitted that no examples of the claimed organosilanes exist in the prior art.

As discussed previously, Wolff *et al.* claims the use of at least one organosilicon compound of formulae (I), represented as  $[R^n_n(RO)_{3-n}Si(Alk)_m(Ar)_p]_q[B]$ . In particular, group B represents  $-SCN$ ,  $-SH$ ,  $-Cl$ , or  $-S_x-$  if  $q = 2$ . R and  $R^1$  represent an alkyl group containing 1-4 carbon atoms. The compounds described by the present invention meet the structural requirements imposed in structure (I). Therefore, the present claims are anticipated by the prior art despite the fact that the claimed compounds are not shown in the examples in Wolff *et al.* Examples are merely specific embodiments of the claims, and they are not construed nor intended to limit the claims.

The Applicants also state that Wolff *et al.* does not describe rubber mixtures containing silicic acid as filler.

This is not true. Use of silica and silicates is described fully in the prior art (col. 3, line 44). Silicic acids are merely hydrated forms of silica. Unless the silica is expressly anhydrous, then it is understood by those in the art that silica and silicic acid are synonymous.

7. The Applicants traverse the rejection of claims 9-14 under 35 U.S.C. 103(a) as being unpatentable over Wolff *et al.* in view of U.S. Patent No. 6,008,295 to Takeichi *et al.* The Applicant's arguments have been considered, but they are not persuasive.

The Applicants submit that Takeichi *et al.* does not obviate the deficiencies of Wolff *et al.* with respect to the missing features of claims 1-8.

There is no reason to use Takeichi *et al.* to obviate deficiencies in Wolff *et al.* because the present claims are anticipated by the primary reference. Takeichi *et al.* was invoked to show that rubber mixtures, in general, could be molded to form tire treads, undertreads, carcasses, side walls, and other tire parts. One skilled in the art is already aware of this particular application for rubber mixtures (as opposed to making a floor mat, for example). Thus, it is maintained that one having skill in the art would find it obvious to use the rubber mixture of Wolff *et al.* to make tire components as well. The Applicants have not shown why such a combination is obvious.

In view of the discussions presented in paragraphs 6 and 7, the rejections of record have not been withdrawn.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

October 30, 2002



DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700